

REMARKS

Rejection of claims 11 and 28 under 35 U.S.C. §102(b)

The Examiner rejected claims 11 and 28 under 35 U.S.C. §102(b) as being anticipated by Kraft. Each of these claims is addressed below.

Claim 11

Claim 11 recites:

11. A portable phone comprising:
 - a position detector that detects geographical position of the portable phone; and
 - a dial mechanism coupled to the position detector for selecting stored text that corresponds to a desired telephone contact, such that when a user selects the stored text, the dial mechanism dials a first stored telephone number when the portable phone is in a first defined region and dials a second stored telephone number when the portable phone is in a second defined region.

In the rejection, the Examiner states that Kraft discloses the dial mechanism in claim 11, citing item 11 in FIG. 1 of Kraft. The Examiner goes on to read the cordless feature of Kraft on the first defined region in claim 11, and the cellular feature of Kraft on the second defined region in claim 11. Applicants respectfully assert that the Examiner has not mapped Kraft onto each and every limitation in claim 11, and has therefore failed to establish a *prima facie* case of anticipation for claim 11 under 35 U.S.C. §102(b). In addition, Kraft does not include all of the limitations in claim 11, so claim 11 is allowable over Kraft.

Failure to establish a prima facie case of anticipation under 35 U.S.C. §102(b)

To establish a prima facie case of anticipation under 35 U.S.C. §102(b), the Examiner must show that Kraft teaches each and every limitation in claim 11. In the rejection, the Examiner maps the user interface 11 in FIG. 1 of Kraft on the dial mechanism in claim 11, reads the cordless feature of Kraft on the first defined region in claim 11, and the cellular feature of Draft on the second defined region. A very cursory analysis shows that the Examiner has not addressed all of the limitations in claim 11. Where is the stored text that corresponds to a desired telephone contact in Kraft? Where does Kraft teach the user selecting the stored text that corresponds to a desired telephone contact? Where does Kraft teach a dial mechanism that dials a first stored telephone number when the portable phone is in a first defined region and dials a second stored telephone number when the portable phone is in a second defined region? The Examiner has failed to identify any teaching in Kraft that reads on any of these three claim limitations addressed above. For this reason, the Examiner has failed to establish a prima facie case of anticipation for claim 11 under 35 U.S.C. §102(b).

Kraft does not teach all limitations in claim 11

Now we get to the substance of the Examiner's rejection of claim 11. The Examiner reads the user interface 11 in FIG. 1 of Kraft on the dial mechanism in claim 11, reads the cordless feature of Kraft on the first defined region in claim 11, and the cellular feature of Draft on the second defined region. With this mapping (the Examiner's own mapping in the rejection) of Kraft on claim 11, Kraft would only anticipate claim 11 if the user interface 11 in FIG. 1 of Kraft allows selecting stored test that corresponds to a desired telephone contact, such that when the user selects the stored text, the user interface 11 dials a first stored telephone number when the portable phone is in cordless mode, and dials a second stored telephone number when the portable phone is in cellular mode. Contrary to the Examiner's rejection, Kraft is devoid of any teaching

whatsoever regarding the dialing of different phone numbers depending on whether the phone is in cordless or cellular mode. Even if this were true, the phone being in cordless or cellular mode does not properly read on two different defined regions. Kraft does disclose automatically detecting when a phone is placed in a certain location, such as a car kit holder, and automatically changing the function of the phone accordingly. However, Kraft does not teach or suggest a dial mechanism that dials a first stored telephone number when the portable phone is in a first defined region and dials a second stored telephone number when the portable phone is in a second defined region.

The user interface 11 in Kraft is a user interface, and does not include any dial mechanism at all. The user interface 11 is described in Kraft at p. 5 lines 30-34, which is devoid of any teaching regarding a dial mechanism. For this reason, the user interface 11 of Kraft cannot read on the dial mechanism in claim 11.

In the rejection, the Examiner states:

Kraft further discloses that the dial mechanism dials a first stored telephone number and communicates the detected geographical position of the portable phone with the call to the first stored telephone number (informing operator of both networks that calls will be diverted to another number based on parameters, page 5, lines 39-53).

The relevance of this statement is unclear in the rejection. Claim 11 does not recite communicating a detected geographical position with a call. To the contrary, claim 11 recites a dial mechanism that dials a first stored telephone number when the portable phone is in a first defined region and dials a second stored telephone number when the portable phone is in a second defined region.

The portable phone in claim 11 allows a user to store text that corresponds to a desired telephone contact with different phone numbers for the telephone contact that correspond to different geographical regions for the telephone contact. The example

given in applicants' specification is for Domino's Pizza. A user could enter the text "Domino's Pizza" in the portable phone, and could then enter different phone numbers that correspond to different defined geographical regions. When the user selects "Domino's Pizza" text from a list of telephone contacts, the portable phone will dial a first stored telephone number if the phone is in a first defined region, and will dial a second stored telephone number if the phone is in a second defined region. In this manner the phone self-detects its geographical position, and dials a number that corresponds to it's self-detected geographical position for the selected text. Nowhere does Kraft or any other known art teach or suggest such function. For this reason, claim 11 is allowable over Kraft, and applicants respectfully request reconsideration of the Examiner's rejection of claim 11 under 35 U.S.C. §102(b).

Claim 28

In rejecting claim 28, the Examiner maps teachings of Kraft on the first two method steps, then states that the third, fourth and fifth method steps are "inherently present" in Kraft based on page 5, lines 25-53 of Kraft. Applicants strenuously assert that Kraft is devoid of ANY of the last three method steps in claim 28.

The Examiner states that the selecting stored text that corresponds to a desired telephone contact is inherently present in Kraft when performing the function of automatic connection with the cordless network, citing page 5 lines 25-53 of Kraft. The Examiner's assertion is not supported by the cited language in Kraft. Nowhere does Kraft teach or suggest the selecting of stored text that corresponds to a desired telephone contact. Furthermore, the Examiner's language in the rejection shows an inconsistency between Kraft and the claim limitation in question. The Examiner's own characterization of Kraft in the rejection refers to "automatic connection with the cordless network". The language in claim 28, in contrast, recites "selecting stored text that corresponds to a desired telephone contact". This step of selecting teaches away from automatic

connection with the cordless network in Kraft. For this reason, Kraft does not teach the selecting of stored text that corresponds to a desired telephone contact as recited in claim 28.

The Examiner then quotes the fourth and fifth method step in claim 28, and states that these method steps are “inherently present” when performing the function of automatic connection with the cordless network, citing page 5 lines 25-53 of Kraft. While this is a creative reading of Kraft, it is not supported by Kraft itself. Nowhere does Kraft teach dialing a first stored telephone number corresponding to the desired telephone contact (corresponding to the selected text in the previous method step) when the portable phone is in a first defined region, and dialing a second stored telephone number corresponding to the desired telephone contact (corresponding to the selected text in the previous method step) when the portable phone is in a second defined region. The method in claim 28 thus allows dialing one of two different phone numbers for a single desired telephone contact depending on the detected geographical position of the portable phone. Nowhere does Kraft teach or suggest these method steps, and they are definitely NOT “inherently present” in Kraft. Because Kraft does not teach or suggest, either explicitly or inherently, the dialing of different phone numbers for a desired telephone contact depending upon the detected geographical position of the portable phone, claim 28 is allowable over Kraft, and applicants respectfully request reconsideration of the Examiner’s rejection of claim 28 under 35 U.S.C. §102(b)

Rejection of claims 1-2, 6, 17-18, 22 and 30-33 under 35 U.S.C. §103(a)

The Examiner rejected claims 1-2, 6, 17-18, 22 and 30-33 as being unpatentable over Kraft in view of Kuwahara. Each of these claims is addressed below.

Claim 1

Claim 1 contains a dial mechanism very similar to the dial mechanism in claim 11, which is addressed in detail above. As a result, claim 1 is allowable for the same reasons given above regarding the allowability of claim 11.

Claim 17

Claim 17 contains limitations (D), (E) and (F) that are identical to the third through fifth method steps in claim 28, which were addressed in detail above. As a result, claim 17 is allowable for the same reasons given above with respect to claim 28.

Claim 30

Claim 30 includes the step of “assigning a telephone number to a defined geographical region”. The Examiner has not addressed this limitation in claim 30, and has therefore failed to establish a *prima facie* case of obviousness for claim 30 under 35 U.S.C. §103(a). Nowhere does Kraft nor Kuwahara teach or suggest assigning a telephone number to a defined geographical region. For this reason, claim 30 is allowable over the combination of Kraft and Kuwahara.

Claims 2, 6, 18, 22, and 31-33

Each of claims 2, 6, 18, 22, and 31-33 depend upon an independent claim that is allowable for the reasons given above. As a result, claims 2, 6, 18, 22, and 31-33 are allowable as depending upon an allowable independent claim.

Rejection of claims 3-5, 7-8, 19-21 and 23-24 under 35 U.S.C. §103(a)

The Examiner rejected claims 3-5, 7-8, 19-21 and 23-24 as being unpatentable over the combination of Kraft, Kuwahara, and Finke-Anlauff. Each of claims 3-5, 7-8, 19-21 and 23-24 depend upon an independent claim that is allowable for the reasons given above. As a result, all of claims 3-5, 7-8, 19-21 and 23-24 are allowable as depending upon an allowable independent claim.

Rejection of claims 13-16 under 35 U.S.C. §103(a)

The Examiner rejected claims 13-16 under 35 U.S.C. §103(a) as being unpatentable over the combination of Bijanki and Kuwahara. Each of these claims is addressed below.

Claim 13

In rejecting claim 13, the Examiner states that Bijanki discloses the ringing of a portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined geographic region, citing col. 5 lines 6-15 of Bijanki. The Examiner then admits that Bijanki does not disclose a processor coupled to the portable phone that determines from the position detector the geographical position of a portable phone. The Examiner then cites to Kuwahara as allegedly teaching this limitation, and states it would have been obvious to one of ordinary skill in the art “to implement the technique of Kuwahara within the system of Kraft in order for the mobile communication terminal to automatically select a ringing tone or vibrator when receiving a call based on the location of the user communication terminal without user intervention to manually select a desired mode to alert an incoming call.” Applicants respectfully submit that the Examiner has not addressed all of the limitations in claim 13, and has therefore failed to establish a *prima facie* case of obviousness for claim 13 under 35 U.S.C. §103(a). Furthermore, the Examiner’s rationale for combining Bijanki and Kuwahara is defective. And even if the combination is proper, the combination of Bijanki and Kuwahara does not teach all of the limitations in claim 13.

Failure to Establish Prima Facie Case of Obviousness for Claim 13

In addressing claim 13, the Examiner continues to address the language of claim 13 as originally filed instead of claim 13 as amended. Claim 13 as amended does not

recite “a processor coupled to the portable phone” as stated by the Examiner, but instead recites “a processor *in* the portable phone.” Because the Examiner has not addressed the proper claim limitation in claim 13, the Examiner has failed to establish a *prima facie* case of obviousness for claim 13 under 35 U.S.C. §103(a).

Defective Rationale for Combining Bijanki and Kuwahara

The Examiner’s rationale for combining Bijanki and Kuwahara states:

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the technique of Kuwahara within the system of Kraft in order for the mobile communication terminal to automatically select a ringing tone or vibrator when receiving a call based on the location of the user.

The Examiner’s stated rationale states that it would have been obvious to implement the technique of Kuwahara within the system of Kraft. But this is clearly not the issue, because the Examiner has not relied upon Kraft in the rejection. Instead, the Examiner has relied upon the combination of Bijanki and Kuwahara. Because the Examiner did not provide a stated rationale for combining Bijanki and Kuwahara, the Examiner has failed to establish a *prima facie* case of obviousness for claim 13 based on the combination of Bijanki and Kuwahara.

Combination of Bijanki and Kuwahara does not teach all limitations in claim 13

The Examiner stated in the rejection:

Bijanki discloses a telephone system . . . that rings the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined geographical region (see col. 5 lines 6-15).

This function cited by the Examiner resides in the phone system, not in the portable phone. The Bijanki system described at col. 5 lines 6-15 of Bijanki is the MSC 114 in FIG. 2 of Bijanki, which is clearly separate from the mobile unit 108. The MSC 114 in Bijanki rings the portable phone. Claim 13, in contrast, recites a processor within the phone itself that rings the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined geographical region. To establish a *prima facie* case of obviousness for claim 13, the Examiner would have to state why one of ordinary skill in the art would be motivated to move the function of the MSC 114 in Bijanki into the portable phone processor. The Examiner has made no such statement, and has therefore (again!) failed to establish a *prima facie* case of obviousness for claim 13 under 35 U.S.C. §103(a).

Even if we make the combination of Bijanki and Kuwahara as suggested by the Examiner, we end up with a system that does not teach all of the limitations in claim 13. In claim 13, it is the processor in the portable phone that “rings the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined region.” In the combination of Bijanki and Kuwahara, it is the MSC 114 in the phone system of Bijanki that makes this decision, not the portable phone itself. Because neither Bijanki, Kuwahara, nor their combination teach or suggest a processor in a portable phone that rings the portable phone when the assigned telephone number of the defined region is called if the portable phone is within the defined region, as expressly recited in claim 13, claim 13 is allowable over the combination of Bijanki and Kuwahara. Applicants respectfully request reconsideration of the Examiner’s rejection of claim 13 under 35 U.S.C. §103(a).

Claims 14-16

Claims 14-16 depend on claim 13, which is allowable for the reasons given above. As a result, claims 14-16 are allowable as depending on an allowable independent claim.

Rejection of claim 27 under 35 U.S.C. §103(a)

The Examiner rejected claim 27 as being unpatentable over the combination of Kraft, Kuwahara and Fitch. Claim 27 depends on claim 17, which is allowable for the reasons given above. As a result, claim 27 is allowable as depending upon an allowable independent claim.

Request to Examiner

Should the Examiner decide to maintain any of the rejections to the pending claims, applicants respectfully request that the Examiner provide a more detailed mapping of the cited art on each and every limitation in the claims so the Examiner's rejections may be adequately addressed on appeal.

Conclusion

In summary, none of the cited prior art, either alone or in combination, teach, support, or suggest the unique combination of features in applicants' claims presently on file. Therefore, applicants respectfully assert that all of applicants' claims are allowable. Such allowance at an early date is respectfully requested. The Examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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